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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Steven Tischer

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EXAMINER

LEVINE, ADAM L

ART UNIT

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3625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/736,470	Applicant(s) TISCHER, STEVEN	
	Examiner Adam Levine	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-15 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-15 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendments and remarks filed November 8, 2007, are responsive to the office action mailed February 7, 2007. Claims 1,4,10, and 21 are amended. Claims 6-7,16-18, and 22-25 have been cancelled. Claims 1-5,8-15, and 19-21 are currently pending and considered in this office action.

Response to Amendment

Pertaining to claim objections in the previous office action

Claim 1 was objected to because of informalities. The claim has been corrected. The objection is withdrawn.

Claims 6,7, and 17 were objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant was required to cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Applicant has cancelled the claims and the objection is therefore moot.

Pertaining to rejection under 35 USC §112 in the previous office action

Claims 1-15, 17, and 19-21 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6-7 and 17 have been cancelled. The amendments to claims 1, 5, 10, and 21 have adequately addressed the grounds for these rejections and they have been overcome.

Response to Arguments

Pertaining to rejection under 35 USC §112 in the previous office action

Applicant's arguments filed November 8, 2007, have been fully considered but they are not persuasive. Claims 1-15, 17, and 19-21 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification describes a third data set generated based on similar first and second attributes from first and second data sets. It does not describe a fourth data set. The claims now are directed to a third data set that is not derived from similar first and second attributes from first and second data sets, but is derived in a manner similar to that originally practiced by only the first and second data sets. The claims are also now directed to a fourth data set that is generated in a manner similar to that only disclosed in the specification as being practiced by the third data set.

Applicant argues that support for these features is found in the specification at paragraphs 0026-0027. This is incorrect. In making this argument applicant claims that the master data set is actually the fourth data set, however, this is simply not the case. While the master data set may be "a" fourth data set, it is quite clearly not the same as the fourth data set in the claim. This is because the fourth data set in the claim has clearly taken the place of what was the third data set in the specification. In the

specification, the third data set is based on similar data associated with first and second attributes. In the claim the third data set is a new uniquely generated data set and the new fourth set is based on similar first, second, and third attributes from the first, second, and now newly introduced third data sets. The master data set is constructed differently than any of the previously numbered data sets, including the fourth data set now claimed. With these amendments, applicant has attempted to expand the entire scope of the invention beyond what was originally disclosed. This is also true with regard to amendments newly filed with the present response.

Pertaining to rejection under 35 USC §103(a) in the previous office action

Applicant's arguments filed November 8, 2007, have been fully considered but they are not persuasive. Applicant argues that the restriction of the generation of each of three data sets to a specific device, namely number one from a digital video recorder, number two from a store computer, and number three from a personal computer is not old and well known. Examiner notes that the official notice was not based on the features being old and well known, but was based on these limitations being matters of obvious design choice. Examiner notes also that if these limitations are not in fact inherent, or obvious variants, then restricting the generation of specific data sets to specific devices is not disclosed in the specification. This rejection has not been made because the examiner does not agree with the applicant's position.

It is clear that the prior art sets are generated by a range of devices including digital video, personal computers, store kiosks, and various other computer devices. It is the examiner's understanding therefore that applicant's amendment intends to limit

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the invention to three data sets generated, specifically, one by a DVR, another by a personal computer, and a third by a store computer, and that these sets are used to generate a fourth set. Applicant asserts that this narrow focus avoids the prior art. It is the examiner's position that the prior art easily and completely encompasses the narrower focus. The prior art sets are generated by devices including digital video, personal computers, store kiosks, and various other computer devices. These devices are interchangeable in the overall prior art system. In other words, the prior art would include a system where three data sets are generated by the three specified devices. It is not however specifically confined to a single such embodiment.

Finally, examiner notes upon further consideration that the limitation is not an obvious matter of design choice, but rather is inherent in the prior art because if the prior art were deprived from the ability to function by deriving specific data sets from specific devices, it would result in random failure of the prior art invention as the method and system would intermittently cease to function whenever that particular arbitrary arrangement arose in the normal course of operation.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1-5,8-15, and 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s)

contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification describes a third data set generated based on similar first and second attributes from first and second data sets. It does not describe a fourth data set. The claims now are directed to a third data set that is not derived from similar first and second attributes from first and second data sets, but is derived in a manner similar to that originally practiced by only the first and second data sets. The claims are also now directed to a fourth data set that is generated in a manner similar to that only disclosed in the specification as being practiced by the third data set.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5,8-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (Paper # 060324; US Patent No. 6,029,195).

Herz teaches a system for comparing attributes of multiple data sets to determine similarities and then create new data sets based on the similarities. Herz further teaches:

- determining when the entity selects a first service or product: generating a first data set having a first attribute associated with the first service or product (see at least abstract, fig.10); wherein the first data set is generated by a digital video recording device and includes a unique identifier associated with an entity, a

date, a time and a title of a program or movie selected by the entity for recording on the digital video recording device (see at least abstract, column 32 line 65-column 33 line 59, column 43 line 53-column 44 line 49, column 39 line 57 – column 40 line 33. Please note: passages show that electronic media includes video and that video recording devices are among the potential devices that generate profile data. Please note: The particular information included in the data set is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106); first device configured to determine whether the entity purchases, submits an order for the first service or product (see at least column 5 lines 36-45, column 18 line 40-column 19 line 7, column 68 lines 5-10, column 77 lines 17-47); a first network device generates the first data set (see at least abstract, fig.1,2); a first device configured to determine when the entity selects a first service or product and generating a first data set having a first attribute associated with the first service or product (see at least abstract, fig.1,2,10,12); first device comprises one of a computer, a cellular phone, or a digital video recording device (see at least fig.1,2).

- determining when the entity selects a second service or product: generating a second data set having a second attribute associated with the second service or

product (see at least abstract); wherein the second data set is generated by a personal computer, the second data set including a unique identifier associated with an entity, a data, a time, and a web address accessed by the personal computer (see at least abstract, figs.1,2; column 7 lines 19-51, column 12 line 61 – column 13 line 41, column 32 line 65-column 33 line 59, column 67 line 30 – column 68 line 21, column 72 line 65 – column 73 line 42); a second device configured to determine when the entity selects a second service or product and generating a second data set having a second attribute associated with the second service or product (see at least abstract, fig.1,2,10);

- determining when the entity selects a third service or product: generating a third data set having a third attribute associated with the third service or product (see at least abstract); wherein the third data set is generated by a store computer, the third data set including a unique identifier associated with an entity, a date, a time, and a title of an item purchased by the entity (see at least abstract, figs.1,2; column 7 lines 19-51, column 12 line 61 – column 13 line 41, column 32 line 65-column 33 line 59, column 67 line 30 – column 68 line 21, column 72 line 65 – column 73 line 42);
- generating a fourth data set based on the first, second, and third attributes: when a portion of data associated with the first attribute matches a portion of data associated with the second attribute and third attribute (see at least abstract, column 5 lines 6-20, column 26 lines 2-21); a third network device generates the third data set (see at least abstract, figs.1,2); a third device

configured to generate a third data set based on the first and second attributes when a portion of data associated with the first attribute is substantially similar to a portion of data associated with the second attribute (see at least abstract, figs.1,2,10; column 5 lines 6-20, column 26 lines 2-21); third device is operably associated with a grid computer network (see at least abstract, figs.1,2); third device comprises a computer server communicating with the first and second devices (see at least figs.1,2); associating at least a first attribute of the first historic data set with at least a second attribute of the second historic data set, the first attribute being substantially similar to the second attribute and generating a third dynamic data set based on at least one of the first and second attributes of the first and second historic data sets (see at least abstract, figs.1,2,10; column 5 lines 6-20, column 26 lines 2-21).

- assigning a plurality of potential interest elements: based on a number of matches between the first, second, and third attributes (see at least abstract, figs.10-15, column 2 line 39 – column 3 line 10).
- ranking the potential interest elements based on the number of matches: between the first, second and third attributes (see at least abstract, figs. 11-12,16; column 4 lines 4-27).
- the data associated with the first attribute comprises textual data: and the data associated with the second attribute comprises textual data and the portion of the data associated with the third attribute comprises textual data (see at least abstract, column 5 lines 6-20, column 9 lines 19-30, column 77 lines 17-47);

generating the third data set based on the first and second attributes includes determining whether at least a portion of the textual data of the first attribute is identical to at least a portion of the textual data of the second attribute and forming the third data set having a third attribute containing at least a portion of textual data from one of the first and second attributes (see at least abstract, column 5 lines 6-20, column 77 lines 17-47).

- entity comprises one of a person or a group of people: (see at least abstract, column 9 lines 31-42. Please note: the identity of the entity has no functional role in the method and a person or group of people are themselves not patentable subject matter.).
- A storage medium encoded with machine-readable computer program code for generating data sets associated with an entity: (see at least column 9 lines 19-30).
- generating a plurality of historic data sets by monitoring activities of a legal entity: (see at least fig.10, column 77 lines 17-47); identifying a plurality of attributes contained in the plurality of historic data sets (see at least figs.5,10, column 77 lines 17-47); determining a plurality of values wherein each value is associated with one attribute of the plurality of attributes and corresponds to a number of historic data sets of the plurality of historic data sets containing the one attribute (see at least fig.12); determining a plurality of dynamic data sets containing the attributes wherein the plurality of dynamic data sets are ranked based on the plurality of values (see at least abstract, fig.12, column 18 line 40-column 19 line

7, column 19 line 29-column 20 line 22, column 77 lines 48-67); iteratively generating the plurality of historic data sets by monitoring activities of the legal entity (see at least abstract, figs.5,10; column 20 line 47-column 21 line 4).

Pertaining to method claims 1-5 and 9

Rejection of claims 1-5 and 9 is based on the same rationale as noted above.

Pertaining to encoded storage medium claim 21

Rejection of claim 21 is based on the same rationale as noted above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (Paper # 060324; US Patent No. 6,029,195) in view of Lammerhuber (Paper # 20061011; US Pub. No. 2003/0079219).

Herz teaches all of the above as noted and teaches a) a unique user identification, b) generating datasets of attributes of products or services, c) associating user identification with datasets, and d) determining the interest of the user in the products or services. Herz and Official Notice do not however disclose a data set generated by a cell phone equipped with a barcode scanner, including a universal product code from a barcode scanned by the barcode scanner, the universal product

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code corresponding to second service or product. Lammerhuber teaches a) a unique user identification, b) generating datasets of attributes of products or services, c) associating user identification with datasets, d) determining the interest of the user in the products or services, and also teaches a data set generated by a cell phone equipped with a barcode scanner, including a universal product code from a barcode scanned by the barcode scanner, the universal product code corresponding to a second service or product (see at least abstract, fig.1, page 1 paras.0004-0009). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Herz and Official Notice to include a data set generated by a cell phone equipped with a barcode scanner, including a universal product code from a barcode scanned by the barcode scanner, the universal product code corresponding to a second service or product as taught by Lammerhuber, in order to increase the range of commercial environments in which the system is useful, thereby increasing commerce using the system.

Examiner cites particular columns and line numbers in the reference as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the reference in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
January 10, 2008

/Yogesh C Garg/
Primary Examiner, Art Unit 3625